

51-19 P U D T

Trial Decision of a Trial for Invalidation, Registration in a Register of the Trial Decision, etc.

1. Timing of Rendering a Trial Decision

When the case has matured to the point of making a trial decision (when all the facts necessary for the proceedings have been considered, all the evidence to be examined has been examined, and a state is reached at which a conclusion can be drawn), an advance notice of the trial decision is made (the Patent Act Article 164-2 (1)), or a trial decision is made by a notice of conclusion of the proceedings (the Patent Act Article 156(2), (4); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4))

With regard to whether the case has matured to the point of making the trial decision, the panel decides by comprehensively considering the following points in general.

- (1) Whether approve or disapprove of the facts are acknowledged by or exchanged between the parties, and what the disputed facts are is clear to the parties and to the panel (normally completed by the first answer stage).
- (2) Whether the point of dispute was subject to proof by the party responsible for proof, and whether the opposing party had an opportunity to counter or rebut (usually completed by oral proceedings, in the first answer stage or the first refutation stage. Additionally, when making a trial decision as “purport of the request” or “purport of the reply” by the opposing party, providing an opportunity for refusal or rebuttal is not necessary).
- (3) Whether there is a need to give the counterparty an opportunity to dispute further by requesting a correction (the Patent Act), correction (the Utility Model Act), or presenting a new reason for invalidation (usually considered at the first answer or the first refutation stage).
- (4) Whether further listening to the counterparty’s argument against one party’s claim

and proof to form the panel's conviction is necessary.

2. Trial Decision of a Trial for Invalidation

(1) Patent, utility model, and trademark

A trial decision on a trial for invalidation includes the following four types:

A. All requests of the defendant are permitted (with regard to patents and utility models, the patent (or utility model registration) relating to all claims for which the defendant requested are invalidated. With regard to trademark registrations, all of the designated goods or services for which the defendant requested are invalidated.)

B. Part of the requests of the defendant are permitted (with regard to patents and utility models, the patent (or utility model registration) relating to a part of the claims for which the defendant requested are invalidated, but other claims are not subject to invalidation). With regard to trademark registrations, the designated goods or services for which the defendant requested are invalidated, but other part of the designated goods or services are not subject to invalidation.) (the Patent Act Article 125; the Patent Act Article 185; the Trademark Act Articles 46-2(1), 69)

C. None of the requests of the defendant is permitted (with regard to patents and utility models, the patent (or utility model registration) relating to all the claims for which the defendant requested are not invalidated. With regard to trademark registrations, all designated goods or services for which the defendant requested are not invalidated.)

D. The request for a trial is dismissed (→ 51-08, 45-04 5.)

(2) Design

Following three are trial decisions on a trial for invalidation.

A. A request of the defendant is permitted.

B. None of the requests of the defendant is permitted.

C. A request for trial is dismissed. (→ 51-08, 45-04 5.)

3. Description of a Trial Decision

(1) General matters in writing the trial decision (→ 45-03)

Because the “conclusion” of the trial decision is the result of a panel’s decision indicating the extent to which the purport of the request by the party of the case has been permitted or excluded, the conclusion should not contain judgments beyond the purport of the request.

The burden of costs relating to the trial for invalidation (the Patent Act Article 123) shall be clearly indicated in the conclusion section, which party should be borne by the ex-officio, regardless of whether the parties have filed a petition.

The point of dispute and the judgment on it are described in the reasons of the trial decision. At that time, in principle, all the reasons (reasons claimed by a defendant and reasons for invalidation ex officio if notified) are examined and judged, and the conclusion of the decision and its specific reasons are shown. However, for the reasons for invalidation that are not directly linked to the conclusion of the trial decision, although the conclusion of the judgment is shown, the degree of the statement, etc. of the reason can be considered appropriate by the panel.

In the case where the decision to accept or decline the amendment of the reason for request is made (→ 51-15 4.(2) (the Patent Act Article 131-2(2); the Design Act Article 52)) and if it is decided to disallow the amendment, the judgment that the amendment of the reason for request, which is on the premise of the denial, changes the gist of the written request are described, and the reason for making such a decision is indicated. (If the defendant is not contesting against the judgment of the gist change, a brief description is acceptable.)

(2) The case of invalidation based on the late coming reason of invalidity

At the conclusion of the trial decision when invalidating the right on the basis of the late-coming reasons (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v),(vi),(vii)), it is desirable indicating clearly when the right falls under the item described above (the Patent Registration Order, Article 9(3); Enforcement Regulations of the Patent Registration Order, Article 37; the Utility Model Registration Order,

Article 3(3); Enforcement Regulations of the Utility Model Registration Order, Article 3(4); Design Registration Order, Article 3(3); Enforcement Regulations of the Design Registration Order, Article 6(4); the Trademark Registration Order, Article 3(4); Enforcement Regulations of the Trademark Registration Order, Article 16 -2).

(3) When there is a request for correction in the patent trial for invalidation (→ 45-04 5. (2)C(c))

A. If allowing the correction or a part of the correction requested in the procedure of the trial for invalidation, the effect of the correction requested by the correction request is produced by stating that effect in the conclusion of the trial decision (the Patent Act Article 134-2(9)→the Patent Act Article 128).

When allowing a correction to delete all the claims requested invalidity, the request for a trial for invalidation is dismissed by the trial decision. (→ 51-08 3. E)

When allowing a correction to delete a part of the claims requested invalidity, the request for a trial for invalidation for the deleted claims shall be dismissed by the trial decision. (→ 51-08 3.E)

B. If the correction requested during the procedure of the trial for invalidation is not allowed, it is not described in the conclusion of the trial decision but in the reason to the effect that no correction is allowed, because the dispute simply against “do not allow correction” provides no benefit.

4. Final and Binding a Trial Decision

Partial final can binding trial decision may occur (the Patent Act Article 167-2). (→ 46-00)

5. Effect of a Trial Decision

(1) Effect of the trial decision to invalidate

A. When the trial decision for invalidation is final and binding, the right is considered not to have existed from the beginning (the Patent Act Article 125; the Utility Model Act Article 41; the Design Act Article 49; the Trademark Act Articles 46-2(1), 68(4)).

B. According to the late-coming reasons for invalidity (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v), (vi), (vii)), if a trial decision to invalidate the right is finalized, the right shall be deemed not to have existed since the right falls under the item (the proviso of the Patent Act Article 125; the Utility Model Act Article 41; the proviso of the Design Act Article 49; the proviso of the Trademark Act Article 46-2(1)).

C. Under the Civil Procedure Code, the trial decision of the case may be a reason for retrial under the Criminal Procedure Code (the Civil Procedure Code, Article 338(1)(viii); the Criminal Procedure Code, Article 435-5). However, with regard to legal treatment under the Civil Procedure Code, if a trial decision for invalidation is final and binding after a court decision of an infringement litigation, etc. is finalized (when the provisions of the Patent Act Article 104-3(i) are applied), the retrial of the final court decision, based on the fact that the trial decision has been made, is limited (the Patent Act Article 104-4(i); 2011 Supplementary provisions of the 2011 Act on partial revision of the Patent Act Article 2(15)).

D. When the trial decision to invalidate a patent or utility model partially is final and binding, only the patent related to the applicable claim is invalidated (the Patent Act Articles 123(1), 185). With regard to a design, even if the design includes the principal design and the related design, only the design subject to invalidation is invalidated, and with regard to a trademark, the invalidation is applied to each of the designated goods and services.

(2) Effect of a trial decision to allow correction in a trial for patent invalidation

A. When a trial decision of a trial for invalidation to allow the correction by the request for correction is decided as per the corrected description, claims, or drawings, it is considered that filing a patent application, an application publication before examination, a decision or a trial decision of a patent grant, and a registration or establishment of a patent right are rendered based on the corrected specification, claims, or drawings (the Patent Act Article 134-2(9)).

B. When a trial decision (limited to those regulated by Cabinet Order) to the effect that correction is to be made becomes final and binding after a court decision for an infringement case, etc. is fixed, a retrial against the fixed court decision based on the reason that the correction is fixed is limited (the Patent Act Article 104-4(iii), Order for Enforcement of the Patent Act Article 8).

(3) Prohibition of double jeopardy in the trial decision of the trial for invalidation

A. If registration of the final trial decision of the trial for invalidation is after April 1, 2012

If a trial decision of a trial for invalidation is finalized, the parties and intervenors of the trial may not request for a trial based on the same fact and the same evidence (the Patent Act Article 167; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)) (→30-02).

B. If the registration of the final trial decision of the trial for invalidation is before March 31, 2012

When there is a registration for a final trial decision of the trial for invalidation, no one can claim a trial based on the same fact and the same evidence.

(4) Effect of a trial decision that a trademark registration should be invalidated because of a late-coming reasons of invalidation

In the case where a trademark registration falls under the Trademark Act Article 46(1)(v), (vi), (vii)), if a trial decision to invalidate the trademark registration is finalized, the trademark right is deemed not to have existed since the time when the trademark registration reached the applicable reason for invalidation (the proviso of the Trademark Act Article 46-2(1)).

Additionally, if identification of when the trademark registration came under the Trademark Act Article 46(1)(v), (vi), (vii)) is not possible, a trademark right is deemed not to have existed from the date of registration (the date of preliminary registration) of the request for trial requested to invalidate the trademark registration (the Trademark Act Article 46-2(2)).

6. Registration, etc.

(1) Preliminary registration of a request for trial

When a request for trial for invalidation is made, it is preliminary registered in the patent registry (the Patent Registration Order, Article 3(4); the Utility Model Registration Order, Article 2; the Design Registration Order, Article 1-3(3); the Trademark Registration Order, Article 1-2(3)).

Preliminary registration is achieved by recording the date (y/m/d) of the request for the trial, a reference number of the trial, and the purport of the request on the display section (Enforcement Regulations of the Patent Registration Order, Article 38; Enforcement Regulations of the Utility Model Registration Order, Article 3(4); Enforcement Regulations of the Design Registration Order, Article 6(4); Enforcement Regulations of the Trademark Registration Order, Article 16-3).

(2) Registration of the final trial decision

The final trial decision of the trial for invalidation is registered under the authority of the Commissioner of the Patent Office (the Patent Registration Order, Article 16-10; the Utility Model Registration Order, Article 6-5; the Design Registration Order, Article 6-3; the Trademark Registration Order, Article 7-5).

The registration is achieved by recording a reference number of the trial, the fact and the date (y/m/d) that the trial decision has been made and the date, and an outline of the final trial decision on the display section (Enforcement Regulations of the Patent Registration Order, Article 37; Enforcement Regulations of the Utility Model Registration Order, Article 3(4); Enforcement Regulations of the Design Registration Order, Article 6(4); Enforcement Regulations of the Trademark Registration Order, Article 16-2(1)). Furthermore, if the trial decision is partially made (→ 46-00), it is registered as a “registration of a partial final decision of the trial decision”.

The original document of the trial decision is considered as a part of the patent registry (the Patent Registration Order, Article 9-3; the Utility Model Registration Order, Article 3(3); the Design Registration Order, Article 3(3); the Trademark Registration Order, Article 3(4)).

(3) Registration of corrections in a specification, claims, or drawings

A correction of the specification, claims, or drawings for a trial for invalidation of a patent or a utility model registration shall be registered under the authority of the Commissioner of the Patent Office (the Patent Registration Order, Article 16-2; the Utility Model Registration Order, Article 6-2). When the title of the patented invention is changed, the changed title shall be registered (Enforcement Regulations of the Patent Registration Order, Article 31; Enforcement Regulations of the Utility Model Registration Order, Article 2-5(2)).

Additionally, when the decision on the correction request is finalized based on the partial final decision of the trial decision (→ 46-00 2.(1)), it is registered in the patent register as a “registration of a partial final decision of the trial decision.”

The specification, claims, and drawings of the patented invention are regarded as a part of the patent registry (the Patent Registration Order, Article 9(2); the Utility Model Registration Order, Article 3(2); the Design Registration Order, Article 3(2); the Trademark Registration Order, Article 3(2)).

(4) Handling when the right becomes extinct

Extinction of the right (including a case of invalidation) is registered under the authority of the Commissioner of Patent Office (the Patent Registration Order, Article 16-1; the Utility Model Registration Order, Article 6-1; the Design Registration Order, Article 6-1; the Trademark Registration Order, Article 7-1).

When extinction of the right is registered, the registration concerning the right in the registry is transferred to the closed registry (the Patent Registration Order, Article 12; the Utility Model Registration Order, Article 4; the Design Registration Order, Article 4; the Trademark Registration Order, Article 5).

The retention period of the closed register is 20 years (Enforcement Regulations of the Patent Registration Order, Article 5(1); Enforcement Regulations of the Utility Model Registration Order, Article 3(2); Enforcement Regulations of the Design Registration Order, Article 6(2); Enforcement Regulations of the Trademark Registration Order, Article 17(2)).

7. Fees and Expenses

(1) Fee

A fee for a request for trial shall be paid in accordance with the provisions under the Patent Act Article 195(2) (the Utility Model Act Article 54(2); the Design Act Article 67(2); the Trademark Act Article 76(2)).

A. Regarding a trial for patent invalidation, a fee must be paid in accordance with the number of claims requested in the trial.

B. If the number of claims above increases due to a correction in a trial for correction or in a request for correction, when the request for a trial for invalidation shall also be filed for the increased additional claims (inventions), the defendant has to pay the fee for those claims (inventions).

(2) Burden of expenses (→ 47-01, 02, 03)

The burden of expenses in a trial for invalidation shall be determined ex-officio, according to a trial decision when the trial is concluded by the trial decision, or according to a decision of the panel when the trial is concluded without a trial decision (the Patent Act Article 169(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

In this case, the burden of expenses shall be considered for the application of the Civil Procedure Code Article 62 etc., which is commonly applied under the provisions of the Patent Act Article 169(2).

8. Others

(1) Certificate of patent (registration)

In the case where a trial decision to allow correction in a specification attached to, claims, or drawing attached to an application is finalized, if the registration is made, the Commissioner of the Patent Office issues a patent (registration) certificate to the patentee (the Patent Act Article 28(1); Enforcement Regulations under the Patent Act Article 66; the Utility Model Act Article 50(1); the Utility Model Registration Order,

Article 1(1); Enforcement Regulations under the Utility Model Act Article 19; the Design Act Article 62(1); Enforcement Regulations under the Design Act Article 16; the Trademark Act Article 71-2(1); Enforcement Regulations under the Trademark Act Article 16-2).

(2) Decision on trial gazette, patent gazette

When a specification, claims, or drawings have been corrected in a trial for invalidation of a patent, the final trial decision of the trial and the corrected specification, the matters described in the claims, and the contents of the drawings are published in the patent gazette (the corrected patent specification) (the Patent Act Article 193(2)(vii), (viii)).

The gazette mentioned above is issued when the case is fixed, and when all the requests relating to the case are decided, the decision on trial gazette is issued in the form of continuously binding the full text of corrected specification (or multiple if there are multiple corrected descriptions). If it is partially finalized, a partial final trial decision gazette is issued and a partial decision information is published.

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